



**REMARKS**

Claims 1 through 3 and 6 through 10 are pending in this application, of which claims 7 and 8 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b).

Accordingly, claims 1 through 3, 6, 9 and 10 are active.

Claims 1 through 3 have been amended, claims 4 and 5 cancelled and new claims 9 and 10 added. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present amendment should be apparent throughout the originally filed disclosure. Applicants submit that the present amendment does not generate any new matter issue.

**Claim 3 was rejected under the second paragraph of 35 U.S.C. § 112.**

In the statement of the rejection the Examiner asserted an inconsistency between the use of “air” in claim 3 and the step of “spraying” in claim 1. This rejection is traversed.

In response, claims 1 and 3 have been amended to clarify that the air is applied, thereby eliminating any perceived inconsistency and eliminating the stated basis for the imposed rejection of claim 3. Clearly, one having ordinary skill in the art would have no difficulty understanding the scope of the claimed invention, particularly when reasonably interpreted in light of and consistent with the written description of the specification, which is the judicial standard. *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 27 USPQ2d 1127 (Fed. Cir. 1993).

Applicants, therefore, submit that the imposed rejection of claim 3 under the second paragraph of 35 U.S.C. § 112 is not viable and, hence, solicit withdrawal thereof.

**Claims 1 through 4 and 6 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Danko.**

In the statement of the rejection the Examiner admitted that Danko does not disclose the notion of pre-cooling to a temperature below a softening temperature or a rod-like extrudate. Nevertheless, and without citation of any additional objective evidence, the Examiner concluded that the claimed invention would have been obvious. This rejection is traversed.

The present invention is directed to a method for producing a spacer rod. As one having ordinary skill in the art would have understood, particularly when interpreting the claimed invention in light of and consistent with the written description of the specification, such a spacer rod must be formed with an accurate sectional shape and a smooth surface. That objective is achieved by maintaining a particular relationship between the temperature of extruded rod when the extruded rod enters into a water pool and a softening point of the extruded rod. In this way the stability of the shape of the rod is maintained to ensure production of an accurate slot. Such concepts are neither disclosed nor suggested by the applied prior art.

The Examiner admitted Danko does not disclose pre-cooling below the softening temperature, but concluded such would have been obvious because it is “commonly practiced in the art.” To whatever extent the Examiner is taking official notice, the Examiner is hereby requested to provide objective evidence of any officially noticed facts. It has been held by the Board of Patent Appeals and Interferences that the failure to provide objective evidence to support an officially noticed fact when requested constitutes reversible error. *Ex parte Natale*, 11 USPQ2d 1222 (BPAI 1988); *Ex parte Nouel*, 158 USPQ 237 (Bd.App. 1967).

The reason why Applicants request objective evidence of the officially noted fact, is that what may or may not be known in **general** does not provide the requisite **specific** motivation to

modify a **specific** reference in a **specific** manner to arrive at a **specifically** claimed invention.

*Ecolochem Inc. v. Southern California Edison, Co.* 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000); *In re Kotzab*, 217 F.3d 1365, 55 USPQ 1313 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999); *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). In fact, in accordance with the present invention, a product different from that disclosed by Danko results and the reason for pre-cooling in the present invention and the type of material pre-cooled are different from those disclosed in Danko.

The present invention is directed to a method of producing a spacer rod made of polyethylene and for storing optical fibers therein. The polyethylene employed in for the spacer rod exhibits good workability. In accordance with the present invention, in order to prevent deformation of the rod caused by water cooling when the rod is cooled in the water pool, pre-cooling is implemented to decrease the temperature of the rod to a temperature, for example of 120°C, lower than the Vicat softening point of the polyethylene. By decreasing the temperature of the rod to a temperature lower than the Vicat softening point of the polyethylene rod, the shape of the spacer for the optical fiber can be stably formed within about 0.1mm.

Applicants point out that the present invention stems from the discovery of the necessity of the pre-cooling the rod just prior to the point where the rod enters into the water pool in view of the softening point of the rod. Accordingly, the claims define a suitable temperature of the rod just before the rod enters into the water pool. By employing such a relationship, it is possible to select an optimum cooling of the rod and an optimum feeding speed of the rod. Such concepts are not even a blip on Danko's radar screen.

Specifically, Danko is directed to a method of making an extruded article of a rigid plastic with a grained surface. Indeed, Danko is directed to a method of making leather-like embossment

on interior equipment of an automobile. The material is a rigid material, such as ABS or polypropylene. Such a rigid plastic, typically, easily adheres to a metal at a high temperature. In order to prevent such adhesion to realize good embossing by a roller for embossing, Danko conducts a pre-cooling step for decreasing a temperature of the metal to a temperature of about 150° at which the interior equipment would not adhere to the metal, i.e., the embossing roller. Thus the purpose for which Danko conducts pre-cooling is completely different from the purpose for which pre-cooling is conducted in accordance with the present invention.

Based upon the foregoing Applicants submit that a *prima facie* basis to deny patentability to the invention defined in claims 1 through 4 and 6 under 35 U.S.C. § 103 has not been established. Indeed, the resulting article and methodology of Danko do not remotely resemble those of the present invention. Applicants, therefore, submit that the imposed rejection of claims 1 through 4 and 6 under 35 U.S.C. § 103 for obviousness predicated upon Danko is not factually or legally viable and, hence, solicit withdrawal thereof.

**Claim 5 was rejected under 35 U.S.C. § 103 for obviousness predicated upon Danko in view of Palmer.**

This rejection is traversed. Indeed, this rejection has been rendered moot by canceling claim 5.

**New claims 9 and 10.**

New claims 9 and 10 are clearly free of the applied prior art for reasons similar to those argued traversing in the imposed rejection of claim 1 under 35 U.S.C. § 103 for obviousness predicated upon Danko. Indeed, as admitted by the Examiner, Danko neither discloses nor suggests

the concept of pre-cooling to a temperature below the softening point of a polyethylene or forming a spacer rod. Danko relates to embossing interior equipment for an automobile. Pre-cooling is employed to prevent adherence of the material to the embossing metal. There is no disclosure in Danko relating to forming a spacer rod to begin with, let alone the pre-cooling step of the present invention for dimensional control.

Moreover, Danko merely discloses water spraying before forming a plate and that the sprayed water functions as a lubricant as well. Clearly, Danko neither discloses nor suggests mist spraying. Rather, Danko employs a shower, wherein the particle size of water droplets is not considered important, and apparently were not important to Danko.

On the contrary, in accordance with the present invention, the particle size employed in claim 9, i.e., is not greater than 80  $\mu\text{m}$ , is significant for keeping the flatness/smoothness of the spacer surface, depending upon the transmission characteristics of the optical fiber incorporated into the spacer. Moreover, any optimization of the particle size for Danko's purpose to prevent adhesion to the metal roller has not been factually established to result in the particle size employed in the present invention for a completely different purpose. Accordingly, claims 9 and 10 are clearly free of the applied prior art.

Based upon the foregoing, it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including

Application No.: 09/937,145

extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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